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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,883	08/27/2001	Volker Breu	20725	4828
151	7590	04/21/2004		
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			EXAMINER TRUONG, TAMTHOM NGO	
			ART UNIT 1624	PAPER NUMBER

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/939,883	BREU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamthom N. Truong	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 January 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-6, 8, 9, 11-15, 17-38, 48-78, 82-86 and 92-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 6, 14, 15, 17-19, 48, 49, 59, 70-72, 75, 76, 82-84 and 92 is/are rejected.
- 7) Claim(s) 2-4, 11-13, 20-38, 50-58, 60-69, 73, 74, 77, 78, 85, 86 and 93-96 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4,6</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

Applicant's amendment of 01-23-04 has been considered. The amended claims have overcome the previous rejection of 112/2<sup>nd</sup> by amending the definition of R<sup>8</sup> to include "alkylene", and not "alkyl". Also, claim 49 has been amended to recite "R<sup>8</sup>" as opposed to R<sup>9</sup>. Thus, the previous 112/2<sup>nd</sup> rejection is withdrawn herein.

Claims 7, 10, 16, 39-47, 79-81, 87-91, and 97-145 have been cancelled. Therefore, only claims 1-6, 8, 9, 11-15, 17-38, 48-78, 82-86, and 92-96 are pending.

The cancellation of non-elected subject matter is appreciated.

An update search yields a reference having one common inventor, and thus, prompts the following new ground of rejection.

### ***Double Patenting***

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-4, 6, 14, 15, 17-19, 48, 49, 59, 70-72, 75, 76, 82-84, and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-9 of U.S. Patent No. 6,696,467 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of formula I of US'467 overlap with those of the instant formula I when the reference's R<sup>1</sup> and R<sup>2</sup> "form a 5- to 10-membered heterocyclic ring", which reads on the definition of the instant R<sup>3</sup> as a *a heteroaryl group*. Although claim 1 of US'467 does not indicate whether the *heterocyclic ring* is aromatic, in the specification, the examples of such a heterocyclyl group include *pyridinyl, fury, thiophenyl* which are aromatic. Thus, it would have been obvious the scope of formula I in US'467 encompasses the scope of the instant formula I.

***Claim Objections***

2. Claims 2-4, 11-13, 20-38, 50-58, 60-69, 73, 74, 77, 78, 85, 86, and 93-96 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Also, claim 11 is an improper dependent claim because it depends on the cancelled claim 11.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624



T. Truong  
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April 15, 2004